

Remarks

This is in response to the non-final Office Action mailed July 6, 2006. Claims 27, 28, 39, 40, and 44 are canceled without prejudice or disclaimer. Claim 24 is amended to incorporate subject matter from claims 27 and 28. Claims 24-26, 29-38, and 41-43 remain pending. Reconsideration and allowance are requested for the following reasons.

In section 2 of the Action, claims 24-27, 38-40, and 44 are rejected under 35 U.S.C. § 102(b) as being anticipated by Anderson et al., U.S. Patent No. 5,909,155. This rejection is respectfully traversed, and the correctness of the rejection is not conceded. Reconsideration is requested for the following reasons.

Preliminarily, it is noted that claims 27, 39, 40, and 44 are canceled.

Claim 24 is directed to a module for containing a circuit. Claim 24 recites, among other limitations, at least one receptacle defined through the front wall for receiving a circuit component, the receptacle having a depth of sufficient magnitude to choke emissions generated within the housing, wherein the depth is greater than .15 inches.

The Action concedes that Anderson fails to disclose a module having a depth greater than .15 inches. The Action states that it would have been obvious to modify Anderson to provide a module having a depth greater than .15 inches, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art.

As stated in the Action, only "result-effective" variables can be optimized. In other words, "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." MPEP 2144.05(II)(B).

Anderson discloses a module 10 with receptacles. However, there is no suggestion in Anderson that the receptacles are of a depth of sufficient magnitude to choke emissions generated within the housing. In contrast, Anderson discloses use of a separate cover 100 to provide EMI shielding. Anderson, column 5, lines 22-33.

The particular parameter at issue, i.e., varying the depth of the receptacles in the module, has not been recognized in the prior art as achieving a particular result, i.e., choking emissions. Therefore, as noted at MPEP 2144.05(II)(B), since the parameter at issue (i.e., the depth of the receptacle) has not been recognized to achieve a particular result in the prior art (i.e., choking

emissions), the depth of the receptacle recited by claim 24 is not a "result-effective variable," and optimization of the depth of the receptacle would not be routine to one skilled in the art. Id.

Claim 24 also recites that the front wall is configured to choke RF emissions to a level such that the module radiates signals that are 100 db down or better from a carrier across a frequency range of 5 megahertz to 1 gigahertz, even in the absence of covers.

The Office Action states that this limitation recites a function that is not a positive limitation to be given patentable weight. However, it is respectfully suggested that this recitation is a positive limitation, in that it requires the front wall to be structured in a specific manner, i.e., to choke RF emissions to a level such that the module radiates signals that are 100 db down or better from a carrier across a frequency range of 5 megahertz to 1 gigahertz. See MPEP 2111.04 (noting that such language can constitute a limitation).

Reconsideration and allowance of claim 24, as well as claims 25, 26, and 38 that depend therefrom, are therefore requested.

In section 4, claims 28-32 and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson. This rejection is respectfully traversed, and the correctness of the rejection is not conceded. Reconsideration is requested for the following reasons.

Subject matter from canceled claim 28 is incorporated into claim 24. Claim 24 is allowable over Anderson for at least the reasons provided above. Reconsideration and allowance of claim 24, as well as claims 29-32 and 42 that depend therefrom, are requested.

In section 5, claims 33-37, 41, and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Vogeles, U.S. Patent No. 4,873,600. This rejection is respectfully traversed, and the correctness of the rejection is not conceded. Reconsideration is requested for the following reasons.

Claims 33-37 and 43 depend from claim 24. Vogeles does not remedy the elements identified above as missing from Anderson. Reconsideration and allowance of claims 33-37 and 43 are therefore requested.

Claim 41 is directed to a module for containing a circuit. Claim 41 recites, among other limitations, at least one receptacle for receiving a circuit, and a non-metallic cover for covering the receptacle.

The Action concedes that Anderson discloses a metallic cover 100 and fails to disclose a non-metallic cover. The Action states that it would have been obvious to construct the metallic

cover of Anderson using a non-metallic material because Vogele teaches the use of a plastic material to form a junction box to prevent corrosion in a harsh marine environment.

It is respectfully suggested that such a modification cannot be made because the substitution of a plastic material for the metallic cover 100 disclosed by Anderson would render the cover unusable for its intended purpose for the following reasons. See MPEP 2143.01(V) (noting that, “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification”). In the present case, cover 100 is made of an electrically conductive material such as metal to provide adequate EMI shielding. Anderson, column 5, lines 22-33. If cover 100 is instead made of plastic, as suggested in the Action, cover 100 would not provide EMI shielding and would therefore be unsatisfactory for its intended purpose. Consequently, there is no motivation to make the suggested substitution of plastic for the metal cover disclosed by Anderson.

Reconsideration and allowance of claim 41 are therefore requested.

Favorable reconsideration in the form of a Notice of Allowance is requested. Please contact the undersigned attorney with any questions regarding this application.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
612.332.5300

Dated: October 6, 2006

Signed: /Robert A. Kalinsky/
Name: Robert A. Kalinsky
Reg. No.: 50,471